



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

P

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,913	06/26/2001	Tara Chand Singhal	11195.33	1401

7590 04/20/2006

STEVEN G. ROEDER
THE LAW OFFICE OF STEVEN G. ROEDER
5560 Chelsea Avenue
La Jolla, CA 92037

EXAMINER

HARBECK, TIMOTHY M

ART UNIT PAPER NUMBER

3628

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/891,913	Applicant(s) SINGHAL, TARA CHAND	
	Examiner Timothy M. Harbeck	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/21/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 19 is objected to because of the following informalities: There are 2 separate claims listed as claim 19. For the purposes of examination the examiner has labeled the first as 19 (a) and the second as 19 (b). Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9-19, 21-29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Brody et al (hereinafter Brody US 2001/0029485 A1).

Re Claim 1: Brody discloses systems and methods enabling anonymous credit transactions comprising the steps of:

- Transferring to a payment system a request by the customer for the transaction (page 2 paragraph 0011; Fig 3)
- Providing information from the payment system to a bankcard authorization network (0045; Fig 3)

- Providing a payment to the merchant to pay for the transaction from the bankcard authorization network (bottom of 0045; Fig 3, Ref 85)

Re Claim 2: Brody discloses the claimed method supra and further discloses the step of providing a payment includes the payment being in a form that does not specifically identify the customer to the merchant (0009; “the transaction between the consumer and the merchant will be anonymous.”)

Re Claim 3: Brody discloses the claimed method supra and further discloses the step of providing a payment includes the step of transferring funds from an existing bankcard of the customer to pay for the transaction (0011)

Re Claim 4: Brody discloses the claimed method supra and further discloses the step of transferring to a payment system includes the step of using a payment card to transfer information regarding the customer to the payment system (Fig 3; Refs 55-60-65-70)

Re Claim 5: Brody discloses the claimed method supra and further discloses the step of using a payment card includes the step of transferring a customer identifier to the payment system, the customer identifier identifying an existing bank card of the customer to the payment system (0033; dynamic mapping of pseudo credit card numbers to real accounts; Also see Fig 3)

Re Claim 6: Brody discloses the claimed method supra and further discloses the step of using a payment card includes the step of providing a payment card that does not include private data of the customer (0028).

Re Claim 7: Brody discloses the claimed method supra and further discloses the step of using a payment card includes the step of providing a payment card identifier for the customer that does not include any private data of the customer (0028).

Re Claim 9: Brody discloses the claimed method supra and further discloses the step of providing a payment card that facilitates the use of a bankcard of the customer without disclosing private data of the customer (0028-0029)

Re Claim 10: Brody discloses the claimed method supra and further discloses the step of providing a payment card that facilitates the use of a plurality of bankcards of the customer without disclosing private data of the customer (0028-0029; 0032 "existing credit cards")

Re Claim 11: Brody discloses the claimed method supra and further discloses the step of collecting a payment from a bankcard of the customer for the transaction (0029; "if the ATS has verified the acceptability of the transaction, the ATS will determine the true credit card number from the anonymous card attributes and will transfer the consumer's true credit card number with the requisite transaction information to the bank. The bank then processes the transaction as any typical credit card transaction.)

Re Claim 12: Brody discloses the claimed method supra and further discloses the step of collecting a payment occurs before the step of providing a payment (0045; Fig 3, Ref 75-80-85; bank clears the charge first (i.e. collects payment) before providing this information to the merchant (pays merchant).

Re Claim 13: Brody discloses systems and methods enabling anonymous credit transactions comprising the steps of:

- Providing a payment card to the customer (0011)
- Using the payment card to interact with a payment system (Ref 65-70), the payment system having information regarding at least one bankcard of the customer (0045; Ref 80)
- Transferring to the payment system a request by the customer for the transaction (0045; Ref 65-70)
- Providing a payment to the merchant for the transaction (0045; Ref 85)

Re Claim 14: Brody discloses the claimed method supra and further discloses the step of providing information to a bank card authorization network from the payment system and the step of providing a payment to the merchant to pay for the transaction includes the bank card authorization network providing the payment (0045)

Re Claim 15: Brody discloses the claimed method supra and further discloses the step of providing a payment includes the payment being in a form that does not identify the customer to the merchant (0009)

Re Claim 16: Brody discloses the claimed method supra and further discloses the step of providing a payment includes the step of transferring funds from an existing bankcard of the customer to pay for the transaction (0011)

Re Claim 17: Brody discloses the claimed method supra and further discloses the step of transferring to a payment system includes the step of using a payment card

to transfer information regarding the customer to the payment system (Fig 3; Refs 55-60-65-70)

Re Claim 18: Brody discloses the claimed method supra and further discloses the step of using a payment card includes the step of transferring a customer identifier to the payment system, the customer identifier identifying an existing bank card of the customer to the payment system (0033; dynamic mapping of pseudo credit card numbers to real accounts; Also see Fig 3)

Re Claim 19(a): Brody discloses the claimed method supra and further discloses the step of providing a payment card includes the step of providing a payment card that does not include private data of the customer (0028).

Re Claim 19(b): Brody discloses the claimed method supra and further discloses the step of providing a payment card includes the step of providing a payment card identifier for the customer that does not include any private data of the customer (0028).

Re Claim 21: Brody discloses the claimed method supra and further discloses the step of providing a payment card that facilitates the use of a bankcard of the customer without disclosing private data of the customer (0028-0029)

Re Claim 22: Brody discloses the claimed method supra and further discloses the step of providing a payment card that facilitates the use of a plurality of bankcards of the customer without disclosing private data of the customer (0028-0029; 0032 "existing credit cards")

Re Claim 23: Brody discloses the claimed method supra and further discloses the step of collecting a payment from a bankcard of the customer for the transaction (0029; "if the ATS has verified the acceptability of the transaction, the ATS will determine the true credit card number from the anonymous card attributes and will transfer the consumer's true credit card number with the requisite transaction information to the bank. The bank then processes the transaction as any typical credit card transaction.)

Re Claim 24: Brody discloses the claimed method supra and further discloses the step of collecting a payment occurs before the step of providing a payment (0045; Fig 3, Ref 75-80-85; bank clears the charge first (i.e. collects payment) before providing this information to the merchant (pays merchant).

Re Claim 25: Brody discloses a method of storing original information relating to a bankcard, the method comprising the steps of:

- Assigning a sequence number to the original information relating to the bankcard (0009)
- Transforming the original information relating to the bankcard into equivalent information that is indistinguishable in format to the original (0009 "dynamic mapping of the card numbers to account numbers or other card numbers such as pseudo-random credit card numbers)
- Storing the equivalent information anchored with the sequence number (0011; "at least one table that associates the consumer's true credit card with the anonymous credit card.")

Re Claim 26: Brody discloses the claimed method supra and further discloses the steps of dividing the original information of the bankcard into a plurality of original elements, transforming the original elements into equivalent elements that are indistinguishable in format to the original elements, and storing the equivalent elements anchored with the sequence number (0009-0012). The method of Brody takes the original bankcard information and through a dynamic mapping process transforms the original attributes, including card number, came, billing zip code and expiration date into pseudo-random attributes (for more details see 0035-0038). These pseudo-random attributes are then stored along side the original attributes in a table (0011-0012), so that a transaction utilizing the anonymous credit card can be related to the true account.

Re Claim 27: Brody discloses the claimed method supra and further discloses wherein the original elements of the bankcard include a bank code, a card number and an expiration date (0009).

Re Claim 28: Brody discloses the claimed method supra and further discloses wherein the step of transforming the original elements, includes the step of transforming the original bank code into an equivalent bank code by accessing a table of all original bank code elements (0035-0037 "it should be appreciated by those of skill n the art that the routing attributes can comprise any number of digits or data located anywhere on the anonymous card, so long as the routing attributes match the routing attributes of the ATS or the affiliated banks and credit card processing networks can recognize the routing attributes to redirect the transaction processing to the correct location."; table noted in 0011-0012)

Re Claim 29: Brody discloses the claimed method supra and further discloses wherein the step of transforming includes transforming the original expiration date into an equivalent expiration date by accessing a table of all original expiration date elements (0035-0037; specifically 0036)

Re Claim 31: Brody discloses the claimed method supra and further discloses the step of transforming the equivalent information to the original information (0012; "at least one table to determine the consumers true credit card from the anonymous credit card.")

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8, 20, 30 and 32-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brody.

Re Claim 8 and 20: Brody discloses the claimed methods 1 and 13 respectively supra but does not explicitly disclose wherein the step of using or providing a payment card includes the step of providing a payment card having a customer identifier maintained within a machine readable are on the payment card. However it was notoriously well known in the art at the time of invention and therefore obvious to anyone of ordinary skill for customer information with regards to a credit card, be maintained within a magnetic strip on the payment card itself. In this way, a merchant

Art Unit: 3628

would simply swipe the magnetic strip into a device where this information can be read and transferred to the appropriate clearing authority. In creating a pseudo credit card, as disclosed by Brody, it would therefore be obvious to include the machine readable magnetic strip, so that the process would mirror the process of a traditional transaction. In this manner the merchant would not know that the card was in fact a pseudo card and the customer's true identity can remain anonymous.

Re Claim 30: Brody discloses the claimed method *supra* but does not explicitly disclose wherein the step of transforming includes transforming the original card number into an equivalent card number by parsing into 4 digit sub-elements and offsetting each sub-element into an equivalent sub-element that is indistinguishable from the original sub-element. However Brody does describe the method of dynamically mapping original numbers into equivalent pseudo numbers for the purposes of an anonymous credit card (0009; 0037-0038). While not disclosing every possible algorithm for mapping numbers, it would have been obvious to anyone of ordinary skill at the time of invention to utilize any mapping method, so long as the method can be reversed to obtain the original number from the pseudo number. In utilizing a number of different mapping combinations and strategies, it would be unlikely for anyone without direct knowledge of the procedure to be able to discern a pattern that would allow them to obtain the original number. The customer's real numbers and identity can therefore remain anonymous, consistent with the goals of the Brody method.

Re Claims 32-51: Further apparatus claims would have been obvious in order to implement all the previously rejected method claims 1-31 and are therefore rejected

Art Unit: 3628

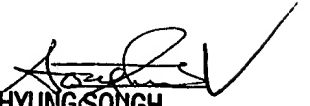
using the same art and associated rationale. Specifically rejections for apparatus claims 32-51 can be related to the rejections of claims 1-2, 4-5, 8, 7, 9-16, 20, 19(a) and 21-24 respectively.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600